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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,952	11/06/2001	Richard J. Wise	053837-5001	4205
9629	7590	03/10/2004	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			RODRIGUEZ, JOSEPH C	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/958,952

Applicant(s)

TANIGAWA, SEIGOU

Examiner

Joseph C Rodriguez

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 9-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Final Rejection

Applicant's arguments filed 12/19/03 have been fully considered but they are not persuasive for reasons detailed below.

The prior art rejections are maintained or modified as follows:

Claims 1, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE '387 in view of Injeski, Jr. ("Injeski")(US' 123) and Weatherby (US '916).

Regarding claims 1 and 8, DE '387 teaches an apparatus (Fig. 1, 2) comprising a first conveyor (a) with paddles (d), a second conveyor (f), a motor (inherent), an enclosure (Fig. 2, surrounding d), and a magnetic assembly (near b).

Regarding claim 6, this feature is present according to the International Search Report.

DE '387 as set forth above thus teaches all that is claimed except for expressly teaching said second conveyor parallel to said first conveyor. The mere positioning of adjacent conveyors, however, is well-known in the conveying arts. For instance, Weatherby (Fig. 1, near e3) and Injeski (Fig. 1, 2, near 22 and 28) both demonstrate that the positioning of adjacent conveyors in parallel is well-known and is a mere design choice dependent on the type of material being conveyed or the desired conveying speed. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of DE '387 with parallel adjacent conveyors as the positioning of conveyors is a mere design choice.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE '387 in view of Injeski and Weatherby as applied to claims 1, 6 and 8 above, and further in view of Soley (US '489).

DE '387 in view of Injeski and Weatherby as set forth above teach all that is claimed except for expressly teaching removably mounting the magnetic separation assembly. Soley, however, teaches this feature by teaching that a variety of magnet types can be used in an assembly, thus implicitly teaching that the magnets can be interchanged via removable mounting (Fig. 1; col. 5, ln. 22-35). Moreover, this feature allows the apparatus to be adapted to meet more specific separation requirements (Id.). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of DE '387 DE '387 in view of Injeski and Weatherby as taught above.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE '387 in view of Injeski and Weatherby as applied to claims 1, 6 and 8 above, and further in view of legal precedent.

DE '387 in view of Injeski and Weatherby as set forth above teach all that is claimed except for expressly teaching an adjustable support, a different magnetic field strength, and speed ratio. These features, however, are well-known in view of legal precedent. For instance, the court has held that adjustability is not a patentable advance. See MPEP 2144.04 IV (D). Further, the court has held that the mere optimization or selection of ranges, such as a field strength or ratio, is non-obvious. See

MPEP 2144.05. Here, the magnetic field strength and speed ratio are common parameters that one with skill in the art would know to adjust dependent on the desired separation parameters. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of DE '387 DE '387 in view of Injeski and Weatherby as taught above.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE '387 in view of Injeski and Weatherby as applied to claims 1, 6 and 8 above, and further in view of what is well known in the art.

DE '387 in view of Injeski and Weatherby as set forth above teach all that is claimed except for expressly teaching the use of magnetic sections of differing compositions. This feature, however, is well-known in the magnet separating arts and Examiner takes Official Notice of such. The mere use of magnets with different compositions cannot be regarded as novel when it is well known to use magnets of different compositions depending on the material to be separated. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of DE '387 DE '387 in view of Injeski and Weatherby as taught above.

Here, it is also noted that Applicant did not timely traverse the Official Notice taken above, thus the use of magnetic sections of differing compositions is now considered admitted prior art.

Election/Restrictions

This application contains claims 9-57 drawn to an invention nonelected without traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Conclusion

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is **703-308-8342**. The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).


The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).

The **UnOfficial** fax phone number for the organization where this application or proceeding is assigned is **703-306-2571** or **703-308-6552**.

The examiner's **UNOFFICIAL Personal fax number** is **703-746-3678**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

March 8, 2004


DONALD R. WALSH
SUPERVISORY PATENT EXAMINER
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